

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PETER FICKEISEN, ORAL AYDIN, ECKEHARDT WISTUBA,  
THOMAS SCHWERZEL, RUDIGER FUSSL and DIETER URBAN

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Appeal No. 1999-1158  
Application No. 08/687,427

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HEARD: December 12, 2001

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Before GARRIS, PAK, and DELMENDO, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 1-8 as amended subsequent to the final rejection. These are all of the claims in the application.

The subject matter on appeal relates to a method of adhering a floor covering to a floor with a floor adhesive comprising an aqueous composition which includes 20-99% by weight of a polymer having a glass transition temperature below -25EC. The polymer is composed of from 60 to 100% by weight of

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certain types of monomers. This appealed subject matter is adequately illustrated by independent claim 1 and dependent claim 8 which read as follows:

1. A method, comprising adhering a floor covering to a floor with a floor adhesive comprising an aqueous composition, free of organic solvents, plasticizers, and additional tackifiers, containing water and

20-99% by weight of a polymer having a glass transition temperature below -25EC, the polymer being composed of (1) from 60 to 100% by weight of C<sub>1</sub>-C<sub>20</sub>-alkyl(meth)acrylates, vinyl esters of carboxylic acids of up to 20 carbon atoms, vinyl aromatics of up to 20 carbon atoms, ethylenically unsaturated nitriles, vinyl halides, non-aromatic hydrocarbons having at least two conjugated double bonds or mixtures of these monomers, and

1-80% by weight of a filler,

the percentages by weight being based on the sum of the components of the aqueous composition, with the exception of water, the floor adhesive being applied to one side of the floor covering.

8. The method of claim 1, wherein the polymer does not contain ethylene monomers.

The references relied upon by the examiner as evidence of non-obviousness are:

Young et al. (Young)	2,976,204	Mar. 21, 1961
Taylor	3,736,283	May 29, 1973
Miyazawa et al. (Miyazawa) (translation copy attached)	50-13428	Feb. 12, 1975

Claim 8 is rejected under the first paragraph of 35 U.S.C.

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§ 112 as being based upon an original disclosure which fails to comply with the written description requirement of this paragraph.

Claims 1-8 are rejected under 35 U.S.C. section 103 as being unpatentable over Young; claims 1-7 are rejected under section 103 as being unpatentable over Young in view of Taylor or Miyazawa; and claim 8 is rejected under section 103 as being unpatentable over Young in view of Miyazawa.

#### OPINION

For the reasons set forth below, we cannot sustain any of the above noted rejections.

With respect to the section 112, first paragraph, rejection, the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

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The section 112, first paragraph, rejection is based on the examiner's belief that the subject matter defined by claim 8 "wherein the polymer does not contain ethylene monomers" does not comply with the written description requirement. However, page 2 of the subject specification as well as original claim 1 (and pending claim 1 on appeal) clearly disclose a polymer composed of up to 100% by weight of monomers which do not include ethylene monomers. This disclosure would convey to the artisan that the appellants, on the application filing date, had possession of polymers embraced by appealed claim 8 wherein the polymers are composed of 100% by weight of non-ethylene monomers. Thus, in applying the above noted test to the facts of this appeal, we are led to the determination that claim 8 complies with the written description requirement of section 112.

It follows that we cannot sustain the examiner's rejection of claim 8 under the first paragraph of 35 U.S.C. section 112.

We also cannot sustain any of the examiner's section 103 rejections. This is because the Young patent, which is the primary reference in each of these rejections, explicitly

discloses using a floor adhesive polymer having a transition temperature<sup>1</sup> between -15°C and +15°C which is substantially outside the here-claimed glass transition temperature range of below -25°C. We find nothing and the examiner points to nothing in the Young reference which would have suggested modifying patentee's transition temperature range so as to fall within the here-claimed range.

In the rejections based on Young in combination with either Taylor or Miyazawa, the examiner concludes that it would have been obvious to replace the adhesive used by Young in his method of adhering a floor covering with the adhesives of either Taylor or Miyazawa. Even assuming an artisan would have made the replacement proposed by the examiner (which is doubtful in light of the disparate utilities of the involved adhesives), it seems clear that the artisan would have used only the replacement adhesive polymers having a transition temperature within the range expressly taught by Young as effective in his method.

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<sup>1</sup> Both the appellants and the examiner, at least implicitly, have considered the "transition temperature" phrase used by Young as synonymous with the "glass transition temperature" phrase recited in appealed claim 1.

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Thus, the examiner's proposed combination of references would not have resulted in the here claimed glass transition temperature.

In summary, none of the section 103 rejections advanced by the examiner on this appeal can be sustained because in each of these rejections the applied prior art contains no teaching or suggestion of the polymer glass transition temperature feature required by the here claimed method.

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The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
CHUNG K. PAK	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

BRG/jrg

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